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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
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08/865,044 05/29/97 APPINO

J P58317U62

EXAMINER

HM12/0412

JACOBSON PRICE HOLMAN AND STERN
THE JENIFER BUILDING
400 SEVENTH STREET NW
WASHINGTON DC 20004-2201

BAHAR

PAPER NUMBER

16

1615

DATE MAILED:

04/12/99

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 5/27/97

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 10-17 and 23-28 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 10-17 and 23-28 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s): _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

#16

08/865,044

05/29/97



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

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HM42/0329

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BAWA, R

1615

03/29/99

Receipt is acknowledged of applicants Status Letters filed February 4, 1999 and March 4, 1999. The application is assigned to examiner Raj Bawa whose telephone number is 703-308-2423.

This application was filed May 29, 1999 and is a continuation of serial number 08/574,689 filed December 19, 1995. The application will be forwarded to the examiner for action. It is expected that an action in this case will be mailed within 30 days from the mailing of this letter.

THURMAN K. PAGE

**SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600**

Thurman K. Page
Supervisory Patent Examiner
Group 1600 Art Unit 1615

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DETAILED ACTION

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10-17 and 23-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCrea et al. (USP 5,292,530).

McCrea et al. disclose topical compositions that contain all four ingredients claimed (abstract, claims). The compositions contain (1) a cosmetic or therapeutic agent (abstract, column 7-8); (2) the identical linear volatile silicone, namely, hexamethyl disiloxane (col.9, line 58, claim 10); (3) silica as the suspending agent (col.10, abstract); and (4) other optional/conventional ingredients (columns 15-16).

The instant invention is directed towards a topical sprayable composition containing hexamethyl disiloxane, therapeutic/cosmetic agent, silica powder and conventional additives or fillers. Furthermore, this composition is contained in a conventional delivery device, absent evidence to the contrary. The method of spraying the topical composition onto the skin is nominal and inherent to the claimed composition.

The cited analogous art lacks a specific disclosure of the %wts. claimed. However, it would be prima facie obvious to optimize the amounts (%wt.) of the ingredients in view of the

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disclosure of McCrea et al. and deliver it topically via conventional delivery devices. Canisters of the type claimed are well known in the art to deliver topically-active compounds (cosmetics or drugs). Note that the cited art is directed to the “topical delivery of a topically-active compound, either cosmetic or medicinal” (column 2, lines 19-20 of McCrea et al.). Additionally, such topical compositions are routinely packaged as pump-sprays (e.g., see column 1, lines 65-66 of McCrea et al.).

Note the scope of the phrase “consisting essentially of” as follows:

Use of the phrase, “consisting essentially of” limits the scope of a claim to the specified ingredients and those that do not materially affect the basic and novel characteristics of a composition. *Ex parte Davis et al.* 80 USPQ 448 (PTO Bd. APP, 1948); *In re Janakirama*, 317 F2d 952, 137 USPQ 893 (CCPA 1963); *In re Garnero*, 412 F2d 276, 162 USPQ 221 (CCPA 1969). Applicant therefore has the burden of showing that the basic and novel characteristics of his composition would be materially changed if the unspecified ingredients not claimed were added. See *In re De Lajarte*, 337 F2d 870, 143 USPQ 256 (CCPA 1964). “Consisting essentially of” is a term open to the inclusion of all elements except for those which “deleteriously change” the basic and novel characteristics of the combination claimed.

The above-mentioned claims are directed towards a composition per se; its future intended use is not at issue from a patentability point of view. No criticality of the concentrations of the ingredients has been established. There is no comparative data of record in

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this case that (i) presents any unexpected results over the closest prior art; or (ii) establishes any improvements over the closest prior art.

The applicant's arguments concerning the presence of wax as an essential ingredient of McCrea have been considered. Note that there is no evidence or data of record to substantiate that an aerosol cannot be formulated in the presence of McCrea's wax. The opinion of the applicant regarding the "results which would likely be obtained" when operating within the scope of the claims is entitled little weight. Note that: (i) the cited art is analogous because it pertains to the field of the inventor's endeavor and is also reasonably pertinent to the particular problem with which the inventor is concerned. *In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q. 2d 1443 (Fed. Cir. 1992); (ii) it is well established that the claims are given the broadest interpretation during examination; and (iii) references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosure. *In re Bozek*, 163 U.S.P.Q. 545 (CCPA 1969).

In light of the foregoing discussion, the Examiner's ultimate legal conclusion is that the subject matter defined by the claims would have been obvious within the meaning of 35 U.S.C. 103(a).

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mr. Raj Bawa, Ph.D. whose telephone number is (703) 308-2423.

The examiner can normally be reached on Tuesday-Friday from 7:30 a.m. to 6:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Page, can be reached on (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Bawa/sg

April 6, 1999

March 31, 1999



**RAJ BAWA, Ph.D.
PRIMARY EXAMINER
GROUP 1600**